

## REMARKS

Claims 1-37 are pending. The claims are amended to avoid any inference that they should be interpreted as “step plus function” in limiting their scope. Claim 34 is also amended to clarify that its kit components are specially adapted to perform the process of claim 1.

Applicants elect with traverse Group I (claims 1-33) for examination on the merits. Applicants reserve the right to prosecute nonelected subject matter in a further patent application.

Notwithstanding the above election, reconsideration of the restriction requirement is requested because examination of all pending claims would not constitute a serious burden. In particular, the claims of Groups I-III should be examined in the same application. Thus, claims 34-37 should not be withdrawn from consideration.

In the alternative, Applicants disagree with the allegation in the Action that claims 1-34 and 36-37 lack unity of invention, and therefore belong to different groups of inventions. Traversal is based on claims 1-34 and 36-37 being so linked as to form a single general inventive concept under PCT Rule 13.1. Therefore, Applicants submit that claims 1-34 and 36-37 should be examined together in this application.

Applicants submit that, in accordance with the M.P.E.P., the claims identified by the Examiner as Groups I and II are linked to form a single general inventive concept. In particular, the Examiner’s attention is directed to M.P.E.P. § 1850 III A Combinations of Different Categories of Claims (8<sup>th</sup> Ed., Rev. 5, August 2006), which states at 1800-96 to 1800-97:

The method for determining unity of invention under Rule 13 PCT shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application: . . .

(B) In addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process . . .

[A]n apparatus or means shall be considered to be specifically designed for carrying out a claimed process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art. Consequently, it would not be sufficient that the apparatus or means is merely capable of being used in carrying out the claimed process. However, the expression “specifically designed”

does not imply that the apparatus or means could not be used for carrying out another process, nor that the process could not be carried out using an alternative apparatus or means.

It was alleged in the Action that the inventions listed by the Examiner as Groups I and II do not relate to a single general inventive concept because they lack the same or corresponding special technical features under PCT Rule 13.2. But here, the special technical feature linking claims 1-34 and 36-37 is a method for determining the amount of template nucleic acid present in a sample comprising i) to iv) according to claim 1 and using the reagents in the kit according to claim 34. In accordance with the section of the M.P.E.P. quoted above, claims 1-33 are directed to a process and claims 34 and 36-37 are directed to the kit or apparatus “specifically designed” for carrying out that process. Accordingly, Applicants submit that there is no lack of unity with regard to claims 1-34 and 36-37.

Upon an indication that the claimed method is allowable, Applicants submit that claims directed to the kit and apparatus would have to be searched and examined. The delay in the search and examination of claims 34 and 36-37 would not result in compact prosecution and is not in the public interest.

Applicants earnestly solicit an early and favorable examination on the merits. The Examiner is invited to contact the undersigned if any further information is required.

Respectfully submitted,

**NIXON & VANDERHYTE P.C.**

By: 

Gary R. Tanigawa  
Reg. No. 43,180

901 North Glebe Road, 11th Floor  
Arlington, VA 22203-1808  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100